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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Epigenomics GmbH

Serial No. 76/000,873

Edward M. Kriegsman of Kriegsman & Kriegsman for
Epigenomics GmbH.

Glenn G. Clark, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Epigenomics GmbH (a
German corporation) to register on the Principal Register
the mark DIGITAL PHENOTYPE for the following goods and
services:

"diagnostic reagents for scientific
purposes including forensic examination;
diagnostic test kits for scientific
purposes, consisting of reagents,
working solutions, plasters, namely,
adhesive tape, slides and solid matrix

material, all sold together as a unit"
in International Class 1;

"diagnostic reagents for medical purposes for diagnosing inflammations, infections, diseases of the central nervous system, heart, circulation, neurologic, endocrine, autoimmune and genetic diseases and cancers, consisting of reagents, working solutions, plasters, namely, adhesive tape, slides and solid matrix material, all sold together as a unit; medical diagnostic test kits consisting of reagents, working solutions, plasters, namely, adhesive tape, slides and solid matrix material, all sold together as a unit, for determining the presence of pathogens in the environment" in International Class 5;

"laboratory equipment, namely, an apparatus for testing a sample, for demonstrating the presence of analytical elements in samples and to determine types of samples in connection with distribution patterns and an apparatus for the production of a series of molecular biological data and parts thereof" in International Class 9;

"providing multiple-user access to the Internet" in International Class 38; and

"research and development services for third parties in the field of diagnostic chemicals, forensic methods, compositions and devices, measuring apparatuses for use in product research and development, in methods for preparation and purification in water treatment plants; methods for testing the environment and determining industrial quality; chemical separation analysis and diagnosis, forensic and medical genetics testing for third parties; computer programming for others

in the field of data processing;
computer services, namely, providing a
searchable database in the field of DNA-
related data on a global computer
network" in International Class 42.¹

The Examining Attorney has finally refused
registration under Section 2(e)(1) of the Trademark Act, 15
U.S.C. §1052(e)(1), on the basis that the mark DIGITAL
PHENOTYPE, when used on and in connection with the goods
and services of applicant, is merely descriptive of them.

Applicant has appealed. Both applicant and the
Examining Attorney have filed briefs. Applicant did not
request an oral hearing.

The Examining Attorney states in his brief that
"applicant's proposed mark, DIGITAL PHENOTYPE, merely
describes the functions, features, uses, characteristics
and purposes of the relevant goods and services," and that
"the most persuasive evidence of record in support of the
refusal under Section 2(e)(1) is the applicant's own web
site" (unnumbered pp. 4-5), which includes the following
statement: "Epigenomics' proprietary technology makes the
detection of hundreds of thousands of DNA methylation
signals a reality. **These signals can be digitized into a**

¹ Application Serial No. 76/000,873, filed March 15, 2000. The
application is based on Section 44 of the Trademark Act, 15
U.S.C. §1126, German Registration No. 399 58 557 (filed September
16, 1999, issued November 19, 1999 and expiring September 30,
2009).

long string of ones and zeros, creating a Digital Phenotype® that reflects genetic activity in a particular cell or tissue, i.e., whether it is functioning normally or whether it is sick." (Emphasis added by Examining Attorney).² The Examining Attorney also points to the following definitions from The American Heritage Dictionary (Third Edition 1992):

- (1) "digital...4. Expressed in digits, especially for use by a computer. 5. Using or giving a reading in digits: a digital clock";³
- (2) "digital computer A computer that performs calculations and logical operations with quantities represented as digits, usually in the binary number system"; and
- (3) "phenotype 1.a. The observable physical or biological characteristics of an organism, as determined by both genetic makeup and environmental influences. b. The expression of a specific trait, such as stature or blood type, based on genetic and environmental influences."

² The Examining Attorney submitted two pages from applicant's website and he quoted the material in his October 24, 2001 Final Office action. The wording on the printouts of both website pages is cut off on the right side and thus, the Board cannot read the full statement from applicant's web pages, but rather only from the Examining Attorney's quote thereof.

³ The Examining Attorney requested in his brief on appeal that the Board take judicial notice of three more dictionary definitions of "digital." The request is granted. See TBMP §712.01.

Further, the Examining Attorney argues that "a 'digital' recording or observation will more accurately record and communicate data and research [than] an 'analog' recording" (brief, unnumbered p. 7); that applicant's goods and services are "digital"; that applicant's laboratory equipment in International Class 9 "is presumed to use or include digital computers"; that "applicant's goods in International Classes 1 and 5 appear to be highly specialized goods that will be used with the applicant's computerized services in International Class[es] 38 and 42 and the computerized laboratory equipment in International Class 9" (brief, unnumbered p. 8); that "the word 'phenotype' describes the functions, features, uses and subject matter of the applicant's services"; and that specifically, "applicant's goods and services are used to digitize the visible properties of an organism that are produced by the interaction of the genotype and the environment." (Brief, unnumbered p. 8.)⁴

⁴ In his brief, the Examining Attorney referred to some of the excerpted stories retrieved from the Nexis database as well as the printouts of pages from third-party Internet sites which he had previously made of record. The stories retrieved from the Nexis database were either uses of the two words "digital" and "phenotype" in completely separate contexts or were uses which referred to applicant corporation and used DIGITAL PHENOTYPE in a trademark manner. Several of these stories were repeats of the same story. Of the few third-party websites, all but one also referred to applicant corporation and generally the term DIGITAL PHENOTYPE was used in a trademark manner.

Finally, the Examining Attorney argues that the two words when combined do not form a unique or incongruous mark with a separate, non-descriptive meaning.

Applicant argues that the Examining Attorney has improperly dissected the mark into its component words and failed to consider the mark as a whole; that the Examining Attorney must establish that the mark, considered in its entirety, immediately describes an ingredient, quality, characteristic, or feature of the identified goods and services, and he has failed to meet his burden of proof; that applicant's goods and services are not "digitized readouts" but are various diagnostic reagents, diagnostic test kits, laboratory equipment, research and development services and Internet access services; that the term is incongruous because the dictionary definitions show the word "digital" refers to expressing in digits, especially for a computer, while the word "phenotype" refers to observable physical characteristics which are not generally reducible to digital expression; and that the mark DIGITAL PHENOTYPE is used exclusively by applicant with no evidence of use by others.

A mark is merely descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." Abercrombie &

Fitch Company v. Hunting World, Incorporated, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See also, In re Abcor Development Corporation, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be merely descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods or services with a "degree of particularity." See In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1978); and In re Entenmanns Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd, unpub'd, Fed. Cir. February 13, 1991.

Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995).

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. See In re Atavio Inc., 25 USPQ2d 1361 (TTAB 1992).

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). In this case, we agree with the Examining Attorney that applicant's goods and services are highly specialized.⁵

The evidence of record (dictionary definitions, printouts of two pages from applicant's website, some excerpted stories retrieved from the Nexis database, printouts from a few third-party websites, and the arguments of the Examining Attorney and applicant) does not establish that the mark DIGITAL PHENOTYPE as a whole is merely descriptive of the identified goods and/or services. See *Bose Corp. v. International Jensen Inc.*, 963 F.2d 1517, 22 USPQ2d 1704 (Fed. Cir. 1992); *In re Classic Beverage Inc.*, 6 USPQ2d 1383 (TTAB 1988); and *Manpower, Inc. v. The Driving Force, Inc.*, 212 USPQ 961 (TTAB 1981), *aff'd* 538 F.Supp. 57, 218 USPQ 613 (EDPA 1982). That is, based on the record now before us, it has not been established that applicant's mark, when used on or in connection with its goods and services recited above, conveys an immediate idea

⁵ A requirement by the Examining Attorney under Trademark Rule 2.61(b) that applicant provide information about its "highly specialized" and rather complex goods and services could have been helpful in this case.

about the goods and/or services with any degree of particularity. It is not clear how the relevant purchasers would regard the term DIGITAL PHENOTYPE; and there is no evidence that the relevant consumers would readily understand a connection between DIGITAL PHENOTYPE and the various diagnostic kits, laboratory equipment, and research and development and Internet access services. The significance of the mark and specifically what it describes about the goods and/or services, when applied to or used in connection with the goods and/or services, is ambiguous and unclear. The Examining Attorney has left too much for speculation and assumption.⁶

The Board has noted many times that if there is doubt about the "merely descriptive" character of a mark, that doubt is resolved in applicant's favor, allowing publication of the mark so that any third party may file an opposition to develop a more comprehensive record. See *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992).

Decision: The refusal to register under Section 2(e)(1) is reversed.

⁶ The Board must assume that the dictionary, Nexis and Internet evidence submitted by the Examining Attorney is the best case possible for the Examining Attorney's position that the mark is merely descriptive of the identified goods and services. See *In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717, 1718 (TTAB 1992).